

REMARKSA. Background

Claims 1-6, 8-19, 21-25, 28, 29, and 31 were pending in the application at the time of the Office Action. Claims 1-6, 8-19, 21-25, 28, 29, and 31 were rejected as being obvious over cited prior art. Applicant has not amended, cancelled, or added claims by this response.

B. Rejection on the Merits

Paragraph 7 of the Office Action rejected claims 1-4, 8-10, 12-17, 21-23, 25, 28, 29, and 31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,928,325 to Shaughnessy et al. in view of U.S. Patent No. 6,654,789 to Bliss et al. Specifically, the Office Action asserts that the Shaughnessy patent discloses the claimed invention except that Shaughnessy "does not specifically teach the recipient choosing at least one of the stored addresses as a preferred address for communication with said recipient; and the recipient selecting a different at least one of the stored addresses as a new preferred address for communication with said recipient." The Office Action then asserts that it would have been obvious to perform these actions in view of the Bliss reference. Applicant respectfully traverses this rejection.

The Shaughnessy patent discloses a method of determining which of many communications paths to use in routing a received message to a user. The decision as to which user device (or devices) is to receive a message is based on predetermined rules. Shaughnessy identifies the various types of select system based rules as a table look up, the format type of the message, the source of the message, or the usefulness of sending a message to a particular device. *Shaughnessy*, col. 5, lines 17-28. The message is then modified and transformed and sent to the user over the various selected

pathways. As the Office Action concedes, Shaughnessy does not disclose the recipient choosing and subsequently changing a preferred address.

In contrast, the Bliss patent discloses a stand-alone system in which a registrant can store a list of current and old email addresses. The registrant can select an entry from the list to be a preferred email address and subsequently select a different entry to be a new preferred email address. Once an entry in the list has been selected by the registrant to be the preferred email address, a system user different from the registrant can manually query the system by typing in a proposed email address. If the proposed email address is in the list set up by the registrant, the system determines the registrant's preferred email address and then displays this address to the user. If the user then desires to send an email to the registrant, the user cannot do so using Bliss. Rather, the user must *manually* use the preferred email address in some other email program. In other words, Bliss does not disclose sending messages to any address nor does it disclose automatically rerouting messages to a preferred address when sent to a non-preferred address. In fact, regarding a user, Bliss only discloses displaying an email address to the user in response to a user's query.

"To establish a *prima facie* case of obviousness ... there must be some suggestion or motivation ... to combine reference teachings." MPEP § 2143. Applicant submits that it would not be obvious to combine the teachings of Bliss with Shaughnessy as proposed in the Office Action because there is no motivation to do so.

The purpose of Shaughnessy is to "dynamically establish... real time communication of incoming messages to one or more user devices presently available to an intended recipient." Shaughnessy Abstract. To do this, the agent in Shaughnessy "polls all identified networks to determine which have user devices available right now and selects one or more of those to receive a

message." Shaughnessy Abstract. Thus, Shaughnessy is directed toward receiving a message and routing it to the intended user based on currently available devices.

Bliss, on the other hand, is only directed toward retrieving and displaying a reference email address to a third party. Bliss has absolutely nothing to do with routing or conveying messages. In fact, it is a stand-alone product which does not lend itself well to combining with other products. The only similarity between Shaughnessy and Bliss is the use of email addresses. However, Shaughnessy and Bliss use email addresses for completely different purposes. While Shaughnessy uses email addresses to determine where to route an incoming message based on pre-established conditions, Bliss uses an email address to simply display to a third party a preferred email address. Applicant submits that the purposes of the references are completely different and that there is simply no logical interrelationship that would support combining the references.

The Office Action seems to assert that because the Bliss reference teaches that a user can change a preferred email address that it would be obvious to combine this isolated teaching of Bliss with the complex routing technology of the Shaughnessy reference. Applicant disagrees. As set forth in the MPEP, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01. Thus, the reason why one skilled in the art would combine the isolated teaching in Bliss with Shaughnessy must be taught in the prior art references. In the present case, because the reason or motivation as to why a user selects a preferred email address in Bliss has no association or relationship to the operations that are performed in Shaughnessy as discussed above, Applicant submits that there is no teaching in the prior art that would motivate such a combination. In view of the foregoing, Applicant respectfully requests that the obviousness rejection with respect to independent claims 1, 14 and 29 be withdrawn.

Claims 2-4, 8-10, 12-13, 15-17, 21-23, 25, 28 and 31 depend from claims 1, 14 or 29 and thus incorporate the limitations thereof. As such, applicant submits that claims 2-4, 8-10, 12-13, 15-17, 21-23, 25, 28 and 31 are distinguished over the cited prior art for at least the same reasons as discussed above with regard to claims 1, 14 and 29. As such, Applicant respectfully requests that the obviousness rejection with respect to these claims be withdrawn.

Paragraph 8 of the Office Action rejected claims 5 and 18 under 35 U.S.C. § 103(a) as being unpatentable over the Shaughnessy patent in view of the Bliss patent and further in view of U.S. Patent No. 901,359 to Malmstrom. Malmstrom was merely cited for disclosing "indication of whether the mobile unit of the recipient is attached to the cellular mobile system or not is received from a Visitor Location Register in said cellular mobile system." Malmstrom does not disclose or suggest the recipient choosing at least one of the stored addresses as a preferred address for communication with said recipient; and the recipient selecting a different at least one of the stored addresses as a new preferred address for communication with said recipient.

Claims 5 and 18 depend from claims 1 and 14, respectively, and thus incorporate the limitations thereof. Because it would not be obvious to combine Bliss with Shaughnessy, as detailed above, and because Malmstrom does not disclose selecting and changing a preferred address, the Malmstrom patent does not cure the deficiencies of Shaughnessy. As such, applicant submits that even assuming, *arguendo*, that it would be obvious to combine Malmstrom with Shaughnessy, claims 5 and 18 are distinguished over the combination for at least the same reasons as discussed above with regard to claims 1 and 14. Thus, Applicant asserts that claims 5 and 18 are in condition for allowance and respectfully requests that the obviousness rejection with respect to claims 5 and 18 be withdrawn.

Paragraph 9 of the Office Action rejected claims 6 and 19 under 35 U.S.C. § 103(a) as being unpatentable over the Shaughnessy patent in view of the Bliss patent and further in view of U.S. Patent No. 6,018,657 to Kennedy, III et al. Kennedy was merely cited for disclosing "determining availability status of a mobile unit by sending short messages to the mobile unit for predetermine [sic] time interval." Kennedy does not disclose or suggest the recipient choosing at least one of the stored addresses as a preferred address for communication with said recipient; and the recipient selecting a different at least one of the stored addresses as a new preferred address for communication with said recipient.

Claims 6 and 19 depend from claims 1 and 14, respectively, and thus incorporate the limitations thereof. Because it would not be obvious to combine Bliss with Shaughnessy, as detailed above, and because Kennedy does not disclose selecting and changing a preferred address, the Kennedy patent does not cure the deficiencies of Shaughnessy. As such, applicant submits that even assuming, *arguendo*, that it would be obvious to combine Kennedy with Shaughnessy, claims 6 and 19 are distinguished over the combination for at least the same reasons as discussed above with regard to claims 1 and 14. Thus, Applicant asserts that claims 6 and 19 are in condition for allowance and respectfully requests that the obviousness rejection with respect to claims 6 and 19 be withdrawn.

Paragraph 10 of the Office Action rejected claims 11 and 24 under 35 U.S.C. § 103(a) as being unpatentable over the Shaughnessy patent in view of the Bliss patent and further in view of U.S. Patent No. 5,915,222 to Olsson et al. Olsson was merely cited for disclosing "transporting short message service messages via the cellular mobile system." Olsson does not disclose or suggest the recipient choosing at least one of the stored addresses as a preferred address for communication with

said recipient; and the recipient selecting a different at least one of the stored addresses as a new preferred address for communication with said recipient

Claims 11 and 24 depend from claims 1 and 14, respectively, and thus incorporate the limitations thereof. Because it would not be obvious to combine Bliss with Shaughnessy, as detailed above, and because Olsson does not disclose selecting and changing a preferred address, the Olsson patent does not cure the deficiencies of Shaughnessy. As such, applicant submits that even assuming, *arguendo*, that it would be obvious to combine Olsson with Shaughnessy, claims 11 and 24 are distinguished over the combination for at least the same reasons as discussed above with regard to claims 1 and 14. Thus, Applicant asserts that claims 11 and 24 are in condition for allowance and respectfully requests that the obviousness rejection with respect to claims 11 and 24 be withdrawn.

No other objections or rejections were presented in the Office Action.

C. Conclusion

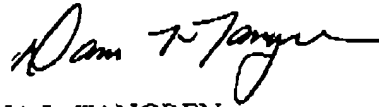
Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited prior art. Most notably, applicant submits that many if not all of the dependent claims are independently distinguishable over the cited art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited art.

In view of the foregoing, applicant respectfully requests the Examiner's reconsideration and allowance of claims 1-6, 8-19, 21-25, 28, 29, and 31.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 22 day of November 2005.

Respectfully submitted,



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